



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,353	06/12/2001	Yasuhiro Toguri-	450100-03281	3903

7590 10/03/2002

William S. Frommer, Esq.
FROMMER LAWRENCE & HAUG LLP
745 Fifth Avenue
New York, NY 10151

EXAMINER

SLOAN, NATHAN A

ART UNIT PAPER NUMBER

2614

DATE MAILED: 10/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/879,353

Applicant(s)

TOGURI, YASUHIRO

Examiner

Nathan A Sloan

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 2614

Drawings

1. Figures 1 and 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance

Specification

2. The disclosure is objected to because of the following informalities: page 19, line 3 "stating position" should read "starting position." Appropriate correction is required.

3. The disclosure is objected to because of the following informalities: page 23, line 15 "slitting the content" should read "splitting the content." Appropriate correction is required.

4. The disclosure is objected to because of the following informalities: page 30, line 29 "and a mouth" should read "and a mouse." Appropriate correction is required.

5.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1,2, and 5-7 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Itakura et al., U.S. Patent No. 6,351,745.

Itakura et al. teach a system used in a communication network that allows clients to access information internet over a broadband connection as well as receive messages such as advertisements. User preferences are stored in a user database and advertisements are sent to users based on their preferences. A billing system is also taught to charge the advertiser based on the advertisements displayed to the user.

With respect to claims 1, 5, and 6, Itakura teaches the claimed information processing apparatus. The claimed first registration means for registering additional information regarding said contents data is met by Itakura's means to store data and identifying information. In column 8, lines 1-11 Itakura teaches storing data which represents the location of the data requested. Itakura further teaches storing the types of operation and user's ID in association with the said data in column 5, lines 61-66. In this manner, Itakura meets the claimed first registration of "information" regarding said contents data. Examiner notes that in the light of the specification, applicant discloses that said additional information is "inherent to the common AV contents among users, e.g., an identification no., a format, a reproduction time, a storage location, a title, a genre, and a copyright" on page 3, lines 30-33. It is noted that applicant discloses this as information known to be prior art.

Furthermore, the claimed "second registration of additional individual information..." is met by Itakura in the registering of client preferences in item S414 of figure 17. User information such as sex, marriage status, occupation, etc. are stored in the message user database 34 of figure 6. Itakura also teaches that a transmittal condition database 36 can record additional information regarding goods that the user has already shown interest in to ensure that suitable advertisements are sent according to user

Art Unit: 2614

preferences in column 10, lines 48-58. The claimed storage means for storing said first and second registration information are thus met by the message user database 34 and the transmittal condition database 36. The databases also meet claim 5 by having a plurality of information regions as seen in figures 7-10.

Furthermore, the claimed extraction means for extracting said additional information and additional individual information are met by the characteristics reader used to retrieve characteristics from the databases in column 27, lines 48-49.

Furthermore, the claimed generation means for generating individual data to be transmitted based on the information regarding contents data and "individual additional information" is met by the message distribution apparatus 39 of figure 1. Itakura teaches receiving a request for a message, followed by the reading of user preferences from said message user database 34 and transmittal condition database 36. Based on user preferences, the URL of messages suitable are generated as taught in column 10, lines 48-58.

Furthermore, the claimed transmission means for transmitting said contents data and additional individual information is met by Itakura in column 11, lines 60-67 and column 12, lines 1-8. Itakura teaches an internet connection with known communication method and message distribution apparatus 39 for distributing said individual data as messages to a terminal 10 of figure 1.

With respect to claim 2, the claimed means for recording charging information on the basis of individual data generated is met by Itakura in the message access log 37 as seen in figure 12. Itakura teaches recording information regarding the access of said individual information data in column 1, lines 9-21.

Art Unit: 2614

With respect to claim 7, the claimed recording medium wherein a program for controlling an information processing apparatus to deliver data over a network is taught by Itakura in the message manager 24. Itakura teaches message viewer software 76 of figure 3 to be installed on the terminal device in a recording medium in column 8, lines 43-67 and column 9, lines 1-3. Itakura further teaches that the recording medium can be a variety of devices such as RAM, DVD's, floppy disks, CD-ROM, tap media, semiconductor memory, etc in column 25, lines 5-24. The software in the terminal device is used to communicate with message manager 24 of figure 1 over the internet. The message manager is taught to send and receive messages with the terminal as well as access databases. In this manner the message manager meets the claimed program because it controls the processing of all limitations set forth and addressed in claim 6.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3, 4, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itakura as applied to claims 1, 2, and 5-7 above, and further in view of Baji et al., U.S. Patent No. 5,027,400.

With respect to claims 3 and 4, all of the limitations that are reflected in claim 1 as addressed above. Itakura does not teach the first registration means registering information by splitting the contents of data per segment, scene, or object. Itakura does

Art Unit: 2614

also not teach the second registration means registering additional information split per segment, scene, or object by said first registration means. Baji teaches a cable distribution network used to transmit regular programming as well as commercials in a television broadcast. Baji explicitly teaches the transferring of desired program and advertisement to the main controller 106 of the head end in column 4, lines 13-17. The main control program then controls the integration of the advertisements with the regular programming, splitting the regular programming up as in claim 3 of applicant and inserting commercial or advertisement scenes as in claim 4 of applicant. The table and method for controlling this process is shown in figure 10 and taught in column 7, lines 46-65. Examiner notes that it is well known in the industry to split up television programs up into scenes with commercials show in between. It would have been obvious for one skilled in the art at the time to modify the user specific advertising methods of Itakura with the data splitting techniques of Baji in order to integrate advertisements with the regularly viewed content.

With respect to claim 8, Itakura teaches the first apparatus as addressed in response to claim 1 above. Itakura does not teach a second apparatus having delivery request means so as to transfer said contents data to said first apparatus. Itakura also does not teach an output means for integrating said contents data and said individual data supplied from the first apparatus. Baji teaches a main control unit 106 for controlling the access of contents data and additional individual data. Baji further teaches a second information apparatus the terminal control unit 113 of figure 1 to be used in conjunction with a delivery request. The commercials may be integrated into the regular contents data by storing commercials in a buffer on the terminal control unit and then integrating

Art Unit: 2614

them into the regular content data in column 8, lines 30-48. In this manner, Baji teaches a delivery request for contents data by the main control unit, claimed first apparatus, and output means in the terminal unit, claimed second apparatus, for integrating the contents data and individual data. It would have been obvious for one skilled in the art at the time to modify the targeted advertisement apparatus of Itakura with the second apparatus of in order to integrate advertisements with regularly viewed content for the user.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hite et al., U.S. Patent No. 6,002, 393, discloses a system and method for targeting tv advertisements to users based on individual consumer habits.

Gardenswartz et al., U.S. Patent No. 6, 055, 573, discloses a system, method, and computer program for delivering a targeted advertisement. Gardenswartz incorporates a registration server to setup user preferences and track consumers with the use of cookies.

Angles et al., U.S. Patent No. 6, 385, 592c discloses an interactive communication system used to deliver advertisements based on personal user profiles. Angles also discloses advertisement, accounting, and registration databases used to link user preferences to advertisements and charge the provider based on advertisement viewing.

Sawyer, U.S. Patent No. 6, 084, 628, discloses a targeted telecommunications advertisement system comprising a central advertisement database.


Art Unit: 2614

Dedrick, U.S. Patent No. 5, 724, 521, discloses an electronic advertisement system having a consumer scale associated with advertisements that match user preferences existing in a user profile database.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan A Sloan whose telephone number is (703)305-8143. The examiner can normally be reached on Monday through Friday from 7:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller, can be reached on (703) 305-4795. The fax phone number for the organization where this application or proceeding is assigned is (703)308-5399.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-3900.


JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600